

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BENNEKER et al.

Appl. No.: Unassigned

Filed: May 16, 2001

For: 4-PHENYLPYPERIDINE
COMPOUNDS

Art Unit: 1625

Examiner: Chang, C.

Atty. Docket: POT-010US3

PRELIMINARY AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

May 16, 2001

Sir:

Prior to a first Office Action on the merits, the following amendments and remarks are respectfully submitted in connection with the above-identified application.

In the Specification

Page 1, before the first line, please insert the following new paragraph:

This application is a divisional under 35 U.S.C. 120 of prior co-pending U.S. Patent Application Serial No. 09/200,743, filed November 30, 1998, the entire contents of which are incorporated herein by reference, which is in turn a divisional under 35 U.S.C. 120 of prior co-pending U.S. Patent Application Serial No. 08/872,023, filed June 10, 1997, now U.S. Patent 5,874,447, the entire contents of which are incorporated herein by reference.

In The Claims

Please cancel claims 1-23 in favor of the following new claims 24-30:

24 (new). A process for preparing paroxetine hydrochloride comprising contacting paroxetine methanesulfonate and hydrochloric acid and thereby forming paroxetine hydrochloride.

25 (new). The process according to claim 24, wherein said paroxetine methane sulfonate is crystalline.

26 (new). The process according to claim 25, wherein said crystalline paroxetine methane sulfonate was prepared by crystallizing paroxetine methane sulfonate from ethyl acetate.

27 (new). Paroxetine hydrochloride made by the process of claim 24.

28 (new). Paroxetine hydrochloride made by the process of claim 25.

29 (new). Paroxetine hydrochloride made by the process of claim 26.

REMARKS

Claims 1-23 have been cancelled and replaced with new claims 24-29 in this divisional application. Support for the new claims is believed to be self-evident. However, for the Examiner's convenience, her attention is directed to, *inter alia*, the description at page 8, line 23, and the surrounding text as well as to original claim 15. Further the Experimental and Example 1 procedures on pages 9-11 of the specification describe the formation of crystalline paroxetine methane sulfonate and in both procedures ethyl acetate is used as the solvent from which the crystals were formed. Accordingly, no new matter has been introduced into the application by the above-amendment.

This divisional application is being filed in response to a restriction requirement issued in the parent application, Serial No. 09/200,743, and to facilitate declaration of a separate interference with claims 2 and 4 of U.S. Patent 6,063,927 to Craig *et al.* As the Examiner is aware, applicants proposed an interference in the parent application that would have involved all the claims in both the parent application and the '927 patent. However, the USPTO has apparently decided to divide the interference into claims directed to crystalline paroxetine methane sulfonate, its compositions, method of using, etc., and to claims directed to converting paroxetine methane sulfonate into paroxetine hydrochloride. This dividing of the interfering subject matter was accomplished by the restriction requirement made in the parent application. Accordingly, Claim 39, which will be cancelled in the parent application to facilitate interference on the former subject matter, is presented here verbatim as claim 24 along with claims 25-29 in order to expedite interference with claims 2 and 4 of the '927 patent.

Specifically, interference is needed because claims 2 and 4 of the '927 patent interfere in fact with claims 24-29 of the instant application. For example, claim 2 of the '927 patent, which describes a product-by-process, would render unpatentable applicants' process of claim 24, if the '927 patent were taken as prior art. Conversely, if applicants' claim 24 were taken as prior art, it would render unpatentable claim 2 of the '927 patent; i.e. the process anticipates or renders obvious the product of the process. Although the claims are technically directed to different statutory classes of invention, that alone does not establish a patentable distinction. Indeed, interferences have been declared where a single count recited in the alternative a virus-resistant plant, a method of producing a virus-resistant plant, a DNA

construct, and a plant cell; meaning that the corresponding claims were directed to the same patentable invention. *Kridl v. McCormick*, 41 USPQ2d 1686, 1687 n.2 (Fed. Cir. 1997). Thus, claims 24-26 are allowable and claim the same patentable invention, as defined above, as claims 2 and 4 of the '927 patent. For this reason alone an interference should be declared.

Applicants have also presented product-by-process claims 27-29. Although applicants believe these claims, as well as claims 2 and 4 of the '927 patent, are not patentable under *In re Thorpe*, 277 USPQ 964 (Fed. Cir. 1985), in view of, *inter alia*, U.S. Patent 4,721,723, applicants have presented these claims out of an abundance of caution and to preserve their legal rights in view of 35 U.S.C. 135(b) and in view of the USPTO's issuance of claims 2 and 4 of the '927 patent. Claims 27-29 above clearly claim the same patentable invention as patented claims 2 and 4 of the '927 patent and interference should be declared. An appropriate interference count could be formulated as follows:

Count 1: Claims 2 or 4 of the '927 patent;

or

Claims 24, 25, 26, 27, 28, or 29 of the instant application.


Accordingly, in accordance with Rule 607(c), applicants bring to the Examiner's attention, that claims 24-29 presented above correspond substantially to claims 2 and 4 of the '927 patent.

In view of the comprehensive Rule 607 Request relating to the instantly claimed subject matter and claims 2 and 4 in the '927 patent that was filed in the parent application and in view of the belated restriction requirement issued thereafter, applicants believe that it is not necessary to submit a formal 607 request in this divisional application. However,

should this not be the case, the Examiner is requested to contact applicants' undersigned representative and a formal 607 Request will be promptly submitted.

Should the Examiner have any questions regarding this matter, she is encouraged to contact Mark R. Buscher (Reg. No. 35,006) at telephone no. (703) 753-8791.

Respectfully submitted,


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